

REMARKS

The Official Action mailed May 20, 2009, and the newly cited prior art applied therein have been carefully reviewed. Claims 1-20 and 24-40 remain in the application, with claims 2, 3 and 38-40 being withdrawn at this time from further consideration. Applicant respectfully submits that the claims of the present application define novel and unobvious subject matter under §§102 and 103, and therefore should be allowed. Accordingly, favorable reconsideration and allowance are earnestly solicited.

Claims 1, 4-20, 24-33, 36, 37 and 41 have been rejected as either anticipated under §102 by, or obvious under §103 from, Takeuchi et al U.S. Application Publication 2003/0033700 (Takeuchi). This rejection is respectfully traversed.

Insofar as Applicant understands the rejection, it appears to be based on the disclosure in paragraph [0093] of Takeuchi that the piezoelectric material may be "any material" containing lead, including either a crystalline or amorphous material.¹ However, Takeuchi does not teach how to make any such an amorphous material, and consequently Takeuchi does not provide an enabling disclosure. A reference which does not provide an enabling disclosure cannot be relied upon as an anticipation of the subject matter which is not enabled. See for example *Impax Laboratories v. Aventis*, 88 USPQ2d 1381 (Fed.

¹ Nothing is said of a "quasi-amorphous" material. Also, what kind of guidance is given to the person of ordinary skill in the art by saying it can be any lead containing material?

Cir. 2008) citing *Finisar Corp. v. DirectTV Group*, 86 USPQ2d 1609, 1618 (Fed. Cir. 2008).

For a reference to be properly anticipatory under §102, the reference must disclose each and every element of the claimed invention, *Eli Lilly and Co. v. Zenith Goldline Pharms., Inc.*, 81 USPQ2d 1324, 1328 (Fed. Cir. 2006), and those elements must be "arranged or combined in the same way as in the claim," *Net MoneyIN Inc. v. VeriSign Inc.*, 88 USPQ2d 1751, 1759 (Fed. Cir. 2008), quoting from *Finisar Corp. v. DirecTV Group Inc.*, *supra*. Takeuchi clearly does not meet the test for anticipation.

The applicability of Takeuchi under §103 also is affected negatively by the fact that Takeuchi does not enable the person skilled in the art to provide such an amorphous material, whatever that might be, and certainly not the claimed quasi-amorphous material. Accordingly, there is really nothing in Takeuchi upon which to base a rejection under §103.

The rejection further appears to be based on assumed inherency, as the rejection states at page four that "the piezoelectric material of Takeuchi is considered to include..."; "Takeuchi is considered to teach a material..."; "the piezoelectric material of Takeuchi is expected to have the same or substantially similar property..." And the "reference inherently meets each of the claimed limitations..."

But inherency cannot be relied upon unless the inherency is reasonably certain or inevitable. According to *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981) the inherency of a feature in a reference must be inevitable, and is not established by possibilities or even probabilities. Please also

see *In re Brink*, 164 UPSQ 247, 249: "Absent a showing [by the PTO] of some reasonable certainty of inherency, the rejection... must fail." Also see *Ex parte Cyba*, 155 USPQ 756, 757 (1967).

Lastly, please see *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.
[citation omitted]

There is no reasonable certainty of inherency, and there is no anticipation or obviousness.

Withdrawal of the rejection is in order and is respectfully requested.

With respect to claim 24, Applicant respectfully invites the Examiner's attention to *In re Luck et al*, 177 USPQ 523, 525 (CCPA 1973), where the Court stated:

..., it is well established that product claims may include process steps to wholly or partially define the claimed product. [citation omitted]
To the extent these process limitation distinguish the **product** over the prior art, they must be give the same consideration as traditional product characteristics.
[emphasis in original]

The process features indeed define the product in the present application, and therefore cannot properly be ignored.

Furthermore, it should be pointed out that language of the type which appears in claim 24, and also now in claim 1, has been held to be proper product claim language. In this regard the Examiner's attention is respectfully invited to *In re*

Steppan et al, 156 USPQ 14, 147. Here, claim 25, rejected as being an improper product by process claim, recited:

"25. An acid phosphate of a condensation product of...."

The Appellants argued that the expression "condensation product" was not a process limitation but merely defined "what the acid phosphate is." The Court at page 148 held claim 25

"...to be a product claim sufficiently definitive to achieve the purposes for which it was drafted..., to particularly point out and distinctly claim applicants' invention, and not a 'product by process' claim per se, as we understand the meaning of those terms."

In an analogous case, *In re Garnner*, 162 USPQ 221, 223, the Court held that

"interbonded one to another by interfusion" is capable of being construed as a structural recitation just as are terms such as "intermixed", "ground in place", "press fitted", "etched" and "welded".

The Examiner may also wish to consult *In re Moore et al* (April 1, 1971), 169 USPQ 236, 237, 239. Here the criticized language was:

"a mixture of highly fluorinated alkyl alkyladamantanes prepared by fluorinating an alkyl damantane."

The Court held that the claims in question were not product by process claims.

The language in question in claims 1 and 24 defines what the product is, i.e. it is a product of application of a

In re Appl of Igor Lubomirsky
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Amendment dated November 20, 2009
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mechanical strain to a substantially amorphous compound, so controlled as to prevent crystallization of the compound.

Claims 34 and 35 have been rejected as obvious under §103 from Takeuchi.

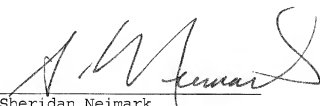
These claims depend from and incorporate the subject matter of claim 1 and are therefore patentable for the same reasons as pointed out above, even without considering the additional unobvious features set forth in the dependent portion of these claims.

Withdrawal of the rejection is in order and is respectfully requested.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (202) 628-5197.

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